



Docket No.: 215207US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

Hiroshi ORIKABE, et al. : ART UNIT: 1712

SERIAL NO: 09/926,370 :

FILED: DECEMBER 28, 2001 : EXAMINER: KEEHAN, C.M.

FOR: THERMOSETTING RESIN COMPOSITION AND FLEXIBLE CIRCUIT  
OVERCOATING MATERIAL COMPRISING THE SAME

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VA 22313-1450

SIR:

In response to the Official Action mailed January 7, 2004, Applicants elect, with  
traverse, for further prosecution, carboxyl as a single disclosed Species of component (B).  
Claims 1, 2, and 6-10 read on the elected species.

REMARKS

The Office has required restriction in the present application by the election of a  
single disclosed Species of functional groups for component (B) from the following list of  
functional groups:

- A) amino;
- B) carboxyl;
- C) acid anhydride;
- D) mercapto;
- E) hydroxyl;
- F) isocyanate; or
- G) hydrazide

Applicants elect, with traverse, for further prosecution, carboxyl as a single disclosed Species of component (B). Claims 1, 2, and 6-10 read on the elected species.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Moreover, the MPEP in §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Election of Species Requirement. Withdrawal of the Election of Species Requirement is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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1712

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**ATTORNEYS AT LAW**

Docket No.: 215207US0PCT

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/926,370

Applicants: Hiroshi ORIKABE, et al.

Filing Date: December 28, 2001

For: THERMOSETTING RESIN COMPOSITION AND  
FLEXIBLE CIRCUIT OVERCOATING MATERIAL  
COMPRISING THE SAME

Group Art Unit: 1712

Examiner: Keehan, C.M.

SIR:

Attached hereto for filing are the following papers:

**Response to Election of Species Requirement**

Our check in the amount of **\$0.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
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